

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77628336
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	

ARGUMENT(S)

REFUSAL: LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration under Section 2(d), claiming the Applicant's mark may be likely to cause confusion with two prior registrations, namely: (1) a registration for "AGVANTAGE" for "purchasing agricultural mortgage-backed securities from lending institutions" owned by the Federal Agriculture Mortgage Corporation, a Federally Chartered Instrumentality of the United States; and (2) a registration for the trademark "AGVANTAGE SOFTWARE" U.S. Trademark Registration No. 2,005,927, was issued in October of 1996, for "computer software for agribusiness, namely general ledger, accounts payable, payroll, accounts receivable, fertilizer, point-of-sale, grain, inventory, feed, patronage, and energy management". This is owned by Udenberg & Associates, of Rochester, Minnesota.

This application should be allowed to proceed to publication for the same or similar reasons – there is no confusion of it with either of the cited references – in each case the goods and/or services are sufficiently distinct to allow them to co-exist without any likelihood of confusion. The Trademark Office has already recognized at least twice before that there can be more than one use of the word AGVANTAGE in agricultural related products based on distinctions in the goods and/or services, and this application is no different.

In this case, the cited registration for "AGVANTAGE" is for the purchasing of agricultural mortgage-backed securities from lending institutions and the customer is therefore a highly sophisticated financial institution selling mortgage-backed securities (a technical financial instrument only understood by those of high skill and sophistication).

The Applicant's services, on the other hand, are directed at customers in the agricultural industry in need of banking and other financial and lease-based services. These consumers are very different than the sophisticated financial institutions selling mortgage-backed securities to the Federal Government and there is no possibility of mistake. The trade channels are obviously different, and the market channels are obviously different. Based on the different services, the difference in the sophistication level of the consumers and the nature of the services offered, there can be no likelihood of confusion. The Trademark Office has obviously taken the position that "AGVANTAGE SOFTWARE" and "AGVANTAGE" can co-exist – presumably because of the difference in services because the word SOFTWARE is obviously merely descriptive (it is disclaimed). This rejection of AGVANTAGE based on the prior registration for AGVANTAGE SOFTWARE is therefore inconsistent.

Furthermore rejecting this application for AGVANTAGE based on a likelihood of confusion with

AGVANTAGE SOFTWARE is treating this application disparately and unequally with the prior registration of AGVANTAGE and AGVANTAGE SOFTWARE.

Based on the foregoing, the Applicant submits that the use or registration of the trademark which is the subject of this application will not cause a likelihood of confusion with the use of "AGVANTAGE" by the Federal Government in purchasing mortgage-backed securities from sophisticated financial institutions, or from AGVANTAGE SOFTWARE for agricultural or software related products/services.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS 036

DESCRIPTION

Banking services; mortgage lending services; agricultural, fishing and timber loans, namely, installments loans, real property loans, timber loans, operations loans, facilities loans, production loans, machinery loans, equipment loans, marketing loans and working capital loans; loan financing; providing loan financing and credit services, and loan evaluation and processing services, to direct suppliers and lenders of agricultural products; loan underwriting services and loan processing services; extending credit for the purchase of agricultural products; leasing services; lease purchase financing and loans

FILING BASIS Section 1(a)

FIRST USE ANYWHERE DATE At least as early as 05/31/2008

FIRST USE IN COMMERCE DATE At least as early as 05/31/2008

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS 036

DESCRIPTION

Banking services; mortgage lending services; agricultural, fishing and timber loans, namely, installments loans, real property loan financing, timber loan financing, operations loan financing, facilities loan financing, production loan financing, machinery loan financing, equipment loan financing, marketing loan financing and working capital loan financing in the field of agriculture, fishing and timber; loan financing; providing credit and loan financing and credit services, and loan evaluation to direct suppliers and lenders of agricultural products; loan financing services; lease purchase financing and loans

FILING BASIS Section 1(a)

FIRST USE ANYWHERE DATE At least as early as 05/31/2008

FIRST USE IN COMMERCE DATE At least as early as 05/31/2008

SIGNATURE SECTION

RESPONSE SIGNATURE /Mark W. Hendricksen/

SIGNATORY'S NAME Mark W. Hendricksen

SIGNATORY'S POSITION Attorney

DATE SIGNED 03/29/2010

AUTHORIZED SIGNATORY YES

CONCURRENT APPEAL NOTICE FILED YES

FILING INFORMATION SECTION

SUBMIT DATE Mon Mar 29 17:22:07 EDT 2010

TEAS STAMP

USPTO/RFR-64.128.84.75-20
100329172207050839-776283
36-4605a373249efdb6ed65e3
f88a5d4c4528e-N/A-N/A-201
00329170838314151

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **77628336** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

REFUSAL: LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration under Section 2(d), claiming the Applicant's mark may be likely to cause confusion with two prior registrations, namely: (1) a registration for "AGVANTAGE" for "purchasing agricultural mortgage-backed securities from lending institutions" owned by the Federal Agriculture Mortgage Corporation, a Federally Chartered Instrumentality of the United States; and (2) a registration for the trademark "AGVANTAGE SOFTWARE" U.S. Trademark Registration No. 2,005,927, was issued in October of 1996, for "computer software for agribusiness, namely general ledger, accounts payable, payroll, accounts receivable, fertilizer, point-of-sale, grain, inventory, feed, patronage, and energy management". This is owned by Udenberg & Associates, of Rochester, Minnesota.

This application should be allowed to proceed to publication for the same or similar reasons – there is no confusion of it with either of the cited references – in each case the goods and/or services are sufficiently distinct to allow them to co-exist without any likelihood of confusion. The Trademark Office has already recognized at least twice before that there can be more than one use of the word AGVANTAGE in agricultural related products based on distinctions in the goods and/or services, and this application is no different.

In this case, the cited registration for "AGVANTAGE" is for the purchasing of agricultural mortgage-backed securities from lending institutions and the customer is therefore a highly sophisticated financial institution selling mortgage-backed securities (a technical financial instrument only understood by those of

high skill and sophistication).

The Applicant's services, on the other hand, are directed at customers in the agricultural industry in need of banking and other financial and lease-based services. These consumers are very different than the sophisticated financial institutions selling mortgage-backed securities to the Federal Government and there is no possibility of mistake. The trade channels are obviously different, and the market channels are obviously different. Based on the different services, the difference in the sophistication level of the consumers and the nature of the services offered, there can be no likelihood of confusion.

The Trademark Office has obviously taken the position that "AGVANTAGE SOFTWARE" and "AGVANTAGE" can co-exist – presumably because of the difference in services because the word SOFTWARE is obviously merely descriptive (it is disclaimed). This rejection of AGVANTAGE based on the prior registration for AGVANTAGE SOFTWARE is therefore inconsistent.

Furthermore rejecting this application for AGVANTAGE based on a likelihood of confusion with AGVANTAGE SOFTWARE is treating this application disparately and unequally with the prior registration of AGVANTAGE and AGVANTAGE SOFTWARE.

Based on the foregoing, the Applicant submits that the use or registration of the trademark which is the subject of this application will not cause a likelihood of confusion with the use of "AGVANTAGE" by the Federal Government in purchasing mortgage-backed securities from sophisticated financial institutions, or from AGVANTAGE SOFTWARE for agricultural or software related products/services.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 036 for Banking services; mortgage lending services; agricultural, fishing and timber loans, namely, installments loans, real property loans, timber loans, operations loans, facilities loans, production loans, machinery loans, equipment loans, marketing loans and working capital loans; loan financing; providing loan financing and credit services, and loan evaluation and processing services, to direct suppliers and lenders of agricultural products; loan underwriting services and loan processing services; extending credit for the purchase of agricultural products; leasing services; lease purchase financing and loans

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 05/31/2008 and first used in commerce at least as early as 05/31/2008, and is now in use in such commerce.

Proposed: Class 036 for Banking services; mortgage lending services; agricultural, fishing and timber loans, namely, installments loans, real property loan financing, timber loan financing, operations loan financing, facilities loan financing, production loan financing, machinery loan financing, equipment loan financing, marketing loan financing and working capital loan financing in the field of agriculture, fishing and timber; loan financing; providing credit and loan financing and credit services, and loan evaluation to direct suppliers and lenders of agricultural products; loan financing services; lease purchase financing and loans

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 05/31/2008 and first used in commerce at least as early as 05/31/2008, and is now in use in

such commerce.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Mark W. Hendricksen/ Date: 03/29/2010

Signatory's Name: Mark W. Hendricksen

Signatory's Position: Attorney

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77628336

Internet Transmission Date: Mon Mar 29 17:22:07 EDT 2010

TEAS Stamp: USPTO/RFR-64.128.84.75-20100329172207050

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